

Serial No. 10/622,776

Attorney Docket No. 26D-010

**REMARKS**

Formal drawings were submitted concurrently with the filing of this application. However, in part 10 of the Office Action Summary, there is no indication of whether the drawings were accepted or objected to by the Examiner. Applicants respectfully request that the Examiner accept the drawings.

Applicants thank the Examiner for acknowledging the claim for foreign priority and for having initialed the PTO-1449 of the Information Disclosure Statements submitted on Dec. 27, 2005 and concurrently with the filing of the application.

In accordance with the election of October 31, 2005, claims 10 – 16 are canceled without prejudice or disclaimer.

Claims 1 – 7 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,373,039 to Sakai *et al.* (hereafter "Sakai"). Claims 1 – 7 have been canceled without prejudice or disclaimer. However, Applicant will respond to this rejection with respect to new claims 17 – 22.

New claim 17 recites the novel embodiment disclosed, for example, on pgs. 9 – 10, of a resin member 40 that is mainly composed of a conductive resin material for grounding and that has a marked part DP formed by laser radiation. The conductive resin material includes a non-conductive resin material; at least 1% by weight of metal filler as a conductive additive to give the non-conductive resin material conducting properties; and 0.01 to 3% by weight of carbon particles to give the marked part marking properties for laser radiation.

Sakai discloses a resin composition including a thermoplastic polymer, carbon black or carbon fibers. The composition is suitable for being marked with a laser. However, Sakai fails

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to disclose that the resin member includes a metal filler to give the non-conductive resin material conductive properties. Therefore, new claim 17 is not anticipated by Sakai.

New claims 18 – 22 depend from new claim 17. Therefore, these claims should also not be anticipated by Sakai for the above-mentioned reasons with respect to claim 17.

Claims 1 – 7 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,262,470 to Shimotsuma *et al.* (hereafter “Shimotsuma”). Applicant will respond to this rejection with respect to new claims 17 – 22.

Shimotsuma discloses a molded article including thermoplastic polyester and carbon black/graphite. The composition permits marking having a high contrast. The composition also includes an inorganic filler as required that may be carbon/steel fibers. However, Shimotsuma fails to disclose that the inorganic filler gives the non-conductive material conductive properties. In contrary, as disclosed on col. 6, lines 48 – 59, the inorganic material is for rendering the thermal stabilizer.

Therefore, because Shimotsuma fails to disclose that the inorganic filler give the non-conductive resin material conductive properties, new claim 17 is not anticipated by Shimotsuma.

New claims 18 – 22 depend from new claim 17. Therefore, these claims should also not be anticipated by Shimotsuma for the above-mentioned reasons with respect to claim 17.

The Examiner stated that the phrase “for grounding” has not been treated with patentability. However, Applicant’s respectfully request that the Examiner treat this phrase with patentable weight because it results in a structural difference between the claimed invention and the prior art. More particularly, as explained above, Sakai and Shimotsuma fail to disclose metal filler as a conductive additive to give the non-conductive resin material conducting properties.

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The conducting properties given by the metal filler are what permit the grounding of the resin member. (See e.g., pg. 2, lines 19 – 20).

Claim 8 was rejected under 35 USC 103(a) as being unpatentable over either Sakai or Shimotsuma in view of U.S. Patent No. 5,409,775 to Harada *et al.* Claim 8 was canceled without prejudice or disclaimer. Therefore, this rejection will not be discussed.

Claim 9 was rejected under 35 USC 103(a) as being unpatentable over either Sakai or Shimotsuma in view of DE 10013000 to Springholtz *et al.* Claim 9 was canceled without prejudice or disclaimer. Therefore, this rejection will not be discussed.

In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,



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